

**REMARKS**

Claims 1-84 have been examined and rejected. By this Amendment, claims 79-84 are cancelled. Thus, claims 1-78 are all the claims pending in the application.

**AMENDMENTS TO THE CLAIMS**

Claims 18, 27, 34, 38, 48, 59, 60-61, 63 and 65 are amended as shown above. Applicant submits that these editorial amendments made to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. These amendments were not made for reasons of patentability.

**INFORMATION DISCLOSURE STATEMENTS**

The Examiner asserts that his equivocal consideration is proper. Applicant respectfully disagrees. As stated in the seventh paragraph of MPEP 609, once the minimum requirements of 37 C.F.R. §§ 1.97-1.98 are met, the Examiner has an obligation to consider the information:

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

MPEP 609. Applicant continues to maintain that the MPEP does not provide for a qualified consideration by the Examiner in initialing a reference listed in an Information Disclosure Statement ("IDS"). Applicant further notes for the record that the Applicant has complied with

its obligations under 37 C.F.R. § 1.56 with respect to the references cited in each IDS filed with respect to the present application.

In the most recent Office Action, the Examiner states that the Applicant admitted to providing only a “portion” of the references cited in the June 19, 2003 IDS. Applicant has made no such statement. With respect to the June 19, 2003 Applicant stated:

Finally, with respect to the June 19, 2003 IDS, the Examiner states that no translation and/or statement of relevancy has been provided. Applicant notes for the record that the IDS was filed with an English-language translation of a Japanese office action. While the Examiner states that this is not acceptable in the text of the present Office Action, the Examiner’s position is directly contradicted by the MPEP sections cited above. By submitting a translation of the Japanese office action, Applicant has satisfied its duty of submitting a concise explanation of the references cited in the June 19, 2003 IDS.

Applicant continues to maintain that it is entitled to unequivocal consideration of the June 19, 2003 IDS. Applicant further asserts that it has met its obligations under 37 C.F.R. § 1.56 and relevant MPEP provisions. Applicant again requests that the Examiner initial this and every other equivocally-considered IDS without qualification.

### **35 U.S.C. § 103(a) REJECTIONS**

**A. Independent Claims 1, 38, 59 and 63 and Dependent Claims 2-8, 18-19, 22-23, 26-27, 30, 32, 34, 36, 39-47, 60-62 and 64-78**

Independent claims 1, 38, 59 and dependent claims 2-8, 18-19, 22-23, 26-27, 30, 32, 34, 36, 39-47, 60-62 and 64-78 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,122,591 to Pomerantz (“Pomerantz”) in view of U.S. Patent No. 6,430,496 to Smith et al. (“Smith”).

**1. The Examiner Has Not Identified The Requisite Motivation To Modify The Teachings Of Pomerantz According To The Teachings of Smith**

In the Amendment Under 37 C.F.R. § 1.111 dated November 4, 2004 ( the “1.111 Amendment”), Applicant asserted that:

As an initial matter, the Examiner has provided no credible motivation to combine the Pomerantz and Smith references. The Examiner asserts that one of ordinary skill would be motivated to combine these references so that a highly automated and efficient system can be realized. However, the Examiner has not identified the source of this motivation.

The teachings of Pomerantz are directed to a taxi trip meter that can detect unscrupulous taxi drivers who, for example, take routes longer than necessary to increase fares. *See* Col. 1, lines 10-17. Pomerantz attempts to solve this problem by determining an actual start time and an actual start location and an actual end time and actual end location. *See* Figs. 2-3. With this information, Pomerantz’s taxi trip meter is able to estimate a fare or trip distance to check against an optimal route distance or fare calculated upon arrival at a destination. The Pomerantz reference contains no teaching of using a central device in its system, i.e., the Pomerantz system is self-contained within the taxi.

Smith, on the other hand, is directed to a system for allowing automation of a dispatching process of vehicles providing transportation services, e.g., ambulances. Smith teaches a system wherein vehicles 20 are dispatched and monitored from a database server 10. *See* Fig. 1.

The Examiner’s asserted motivation to combine the references is one of automation and efficiency. This argument, boiled down, is that one of ordinary skill in the art would be motivated to improve the Pomerantz reference by combining its teachings with the teachings of Smith. This is an impermissible hindsight reconstruction of the Applicant’s invention. There is no mention of a need for additional automation or efficiency in the Pomerantz reference. Adding a central device to Pomerantz’s system would complicate Pomerantz’s system. Further, the Pomerantz system is automated. The determinations made in the Pomerantz system occur at trip meter 12, taximeter 11, location sensor 14 and computer 10 and, thus, the system is purportedly automated. *See* Fig. 1. There is no implied or explicit teaching in Pomerantz that its system would benefit from further automation. The Smith reference purports to disclose a system that eliminates human involvement except in rare instances, thus, Smith teaches a system that is purportedly automated and efficient. Thus, the Examiner’s asserted motivation of automation and efficiency cannot come from the Smith reference. Therefore, the Examiner’s asserted motivation can only have come from the Applicant’s disclosure.

Thus, because the Examiner has provided no credible motivation to combine the Pomerantz reference with the Smith reference, the Examiner's 35 U.S.C. § 103(a) rejection must fail.

Applicant reasserts the above arguments.

In response to the Applicant's assertion that the Examiner has failed to provide a credible motivation to combine the Pomerantz reference with the Smith reference, the Examiner states that "[a] primary reference in a 103 rejection does not need to recognize or discuss a feature being provided by a secondary reference." The Examiner's argument misses the point.

It is black letter law that the Examiner must identify a suggestion or motivation to modify the references when making a rejection under 35 U.S.C. § 103. *See, e.g.*, MPEP 2143.03. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (emphasis in original). Here, the Examiner is combining Pomerantz with Smith. The alleged motivation for such combination is so that "a highly automated and efficient system can be realized." Office Action at p. 4. This is, however, an impermissible hindsight reconstruction of the Applicant's invention. There is no implicit or explicit mention of a need for additional automation or efficiency in either the Pomerantz reference or the Smith reference. While going to great lengths to rebut Applicant's arguments with citations to the references of record, the Examiner has notably failed to identify where in any reference of record the alleged motivation for combining the references can be found. Thus, Applicant again alleges that the rejection premised on the combination of Pomerantz and Smith must fail for this reason alone.

Further, the Applicant's argument that modifying Pomerantz according to Smith would lead to a more complicated system is not intended as an argument that an obviousness rejection

must fail when the device resulting from the combined reference is more complicated. Rather, Applicant offers this argument as further evidence of why one of ordinary skill in the art would not be motivated to combine the two references at issue, *i.e.*, Pomerantz and Smith. Absent any teaching or suggestion of a need for further automation or an inefficiency in either system, one of ordinary skill in the art is not likely to be motivated to combine these two references where the resultant system is one of greater complexity, overhead and administrative burdens.

The Examiner's hypothetical of combining a car with an antilock braking system ("ABS") provides a clear example of when one of ordinary skill in the art would be motivated to combine references. The ABS art is chock full of the shortcomings of traditional braking systems, e.g., uncontrolled skids on slippery pavement during hard braking. One of ordinary skill in the art would be motivated by this teaching in the ABS art to combine ABS with a non-ABS vehicle due to a suggestion in the art of improved safety characteristics when combined. There is, however, no such suggestion or motivation in the art the Examiner has applied to the Applicant's claimed invention.

The Examiner further argues that Applicant's argument would render 35 U.S.C. § 103 useless because a reference could not be used in a 35 U.S.C. § 103 rejection if it did not qualify as a anticipatory reference under 35 U.S.C. § 102. Applicant does not allege that each feature must be taught in the primary reference, rather Applicant alleges that there must be a motivation to combine the references. Undoubtedly, features missing from a primary reference may, in appropriate circumstances, be found in a secondary reference, however, there must be a motivation to combine the references.

Still further, in addition to be legally insufficient, the Examiner's asserted motivation has no motivation in fact. It is not at all clear what further automation is had by combining the teachings of Pomerantz and Smith. Pomerantz is already an automated system. The driver is not calculating fares and baselines routes -- this is done by the taxi trip meter system taught by the reference. Nothing in the Examiner's rejection provides any further automation of this system or the processes it allegedly performs. Further, it is unclear what greater efficiency is had by combining the teachings of Smith and Pomerantz. Taking as true the Examiner's assertions regarding the teachings of Pomerantz and Smith, combining the two references requires information to leave Pomerantz's taxi, be sent to Smith's database server, have various operations performed at the database server, and then finally be sent back to Pomerantz. This is in opposition to Pomerantz where all of the routing steps the Examiner asserts occur take place within the confines of the taxi. The Examiner's combination does not result in a necessarily more desirable or more efficient system. Delay is inevitable when the information is processed outside of the taxi. A entirely new layer of administrative difficulties is placed on the system. Someone is required to monitor and maintain the supposed central database server. One problem with the database server cripples the entire taxi fleet (as opposed to just the one taxi with a problem). The Examiner's combination is a more costly and burdensome system, not a more efficient one.

**2. Even if Properly Combined, the Combination of Pomerantz and Smith Fails to Teach Each Element of the Rejected Claims**

With respect to claim 1, a combination of Pomerantz and Smith would fail to result in a system as recited therein. Neither reference discloses a center equipment configured to receive present-location information and destination information from a vehicle as recited in claim 1.

Pomerantz discloses no structure that would correspond to the claimed center equipment as the Examiner acknowledged. To overcome this admitted deficiency, the Examiner argues that Smith's database server 10, ITS system, communications means 22, and map storage means (co. 2, lines 1-5) provide the missing center equipment. However, even if combined as the Examiner asserts, the combination of Pomerantz and Smith fail to teach

a center equipment configured to receive said present-location information and destination information, to find an optimal route to obtain optimal-route information in accordance with said present-location information and destination information, and to transmit information including, said optimal-route information, to said at least one vehicle

as recited in claim 1.

Smith's database server 10, ITS system, communications means 22, and map storage means, by themselves, are not configured to receive present-location information and destination information, to find an optimal route to obtain optimal-route information in accordance with the present-location information and destination information, and to transmit information including, said optimal-route information, to said at least one vehicle. The Examiner does not argue that Smith's system alone has the structure as set forth in claim 1. It is the Examiner's position that one of ordinary skill in the art would take Pomerantz's teachings (which do not include sending location or destination information to a central equipment) and incorporate Smith's database server 10, ITS system, communications means 22, and map storage means. However, even doing so, there is a complete absence of any teaching of a center equipment configured to find optimal route information based on information sent to it. The Examiner attempts to counter this missing element by arguing that it would be obvious based on an allegedly known desire to have a highly automated and efficient system. Even if this alleged motivation is applied to the

references at hand, there remains an absence of a center equipment configured to find optimal route information. Pomerantz fails to teach this center equipment, as the Examiner acknowledges. The Examiner argues that Figs. 3L-1 and 3L-2 suggests the claimed center equipment. However, as is clear from Fig. 3L-1, the determined route is not from a present location, but rather from a pick up address. Smith does not teach obtaining route information from a present location, but instead from a pick-up location. Thus, Applicant submits that claim 1 is patentable over the combination of Pomerantz and Smith at least for this additional reason.

Independent claims 38, 59 and 63 contain similar limitations and are patentable for analogous reasons. Dependent claims 2-8, 18-19, 22-23, 26-27, 30, 32, 34, 36, 39-47, 60-62 and 64-78 depend from the rejected independent claims and are patentable at least based on their respective dependencies.

**B. Independent Claims 9 and 48 and Dependent Claims 10-17, 20-21, 24-25, 28-29, 31, 33, 35, 37 and 49-58**

Independent claims 9 and 48 and dependent claims 10-17, 20-21, 24-25, 28-29, 31, 33, 35, 37 and 49-58 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Pomerantz in view of Smith in further view of U.S. Patent No. 5,802,492 to DeLorme ("DeLorme"). As independent claims 9 and 48 and dependent claims 10-17, 20-21, 24-25, 28-29, 31, 33, 35, 37 and 49-58 contain elements similar to those distinguished above with respect to claim 1, Applicant submits that these claims are patentable for analogous reasons.

**CONCLUSION**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the



Amendment Under 37 C.F.R. § 1.116  
US Appln No.: 09/851,248

Docket No.: Q64412

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

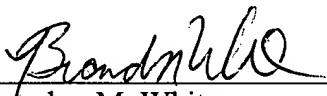
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

  
\_\_\_\_\_  
Brandon M. White  
Registration No. 52,354

Date: March 31, 2005